UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,895	12/19/2001	Jani Pirkola	413-010762-US(PAR)	3213

2512	7590	09/22/2004

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER
RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
2681	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/027,895	PIRKOLA ET AL.
	Examiner	Art Unit	
	Eliseo Ramos-Feliciano	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 December 2001</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>19 December 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

    1.☒ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6, 7</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   **Claim 22** is objected to because of the following informalities: the claim as written may

lead to confusion. It is suggested that the claim be rewritten as: -- 22 (Amended). <u>Software</u>

<u>means</u> [An application program] according to claim 21 <u>further comprising an application</u>

<u>program</u> stored on a data transfer medium, in the memory of a terminal, on a SIM card of a

terminal, or in a cellular network device. --. Appropriate correction is required.

2.   **Claims 1-6** are objected to because of the following informalities: method claims should

be written in active form including steps for performing a function. The following are some

exemplary suggestions of how to correct the claims:

> claim 1, line 4: instead of "a check is made for the calling party", rewrite as --making a
>
>> check for the calling party--,
>
> claim 1, line 6: instead of "a decision is made about the establishment of", rewrite as --
>
>> making a decision about the establishment of--,
>
> claim 2, line 4: instead of "the receiving party's number is dialled", rewrite as --dialing
>
>> the receiving party's number--,
>
> similar changes for the rest of the claims are suggested.

Appropriate correction is required.

3.   **Claim 18** is objected to because of the following informalities: in the first line of the

claim "the SIM card" should be --a SIM card-- since it is the first time a SIM card is recited.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1-3, 7-12, and 14-22** are rejected under 35 U.S.C. 102(e) as being anticipated by

Tuomela et al. (US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 1**, Tuomela et al. discloses a method for establishing and making a

check for a communications connection, in which method an electrical communications

connection is set up between a calling party and receiving party (Figure 2), in which method

before establishing the communications connection proper,

a check is made for the calling party concerning the ability of the receiving party to

receive the message (call) sent by the calling party and, ("check context information", see Figure

2, element 2; see also page 1, paragraph 0010)

based on that information, a decision is made about the establishment of the

communications connection proper. (for example: a decision is made between leaving a message

for the user, or causing the call to ring the user's phone, see page 1, paragraph 0008, especially

the last three lines; and the abstract).

The "context information" indicates a receiving party's activity, place or location and/or

environment; see pages 1-2, paragraphs 0015-0016 and 0019.

Regarding **claim 2**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the check for the calling party concerning the ability of the receiving party to receive the message (call) of the calling party includes steps in which

the receiving party's number is dialed, (Figure 2, element 1)

the activity status data of the receiving party (context information) are fetched from an activity log (at WAP context server 7), (Figure 2, element 2; page 1, paragraphs 0009-0010)

possible options of action are presented (page 2, paragraphs 0024-0031) and the best of them ("preferred selection") is selected, (page 2, paragraphs 0022 and 0033).

it is examined whether the option of action is possible, and (The list presented to the calling party, shown in paragraphs 0026-0031, are "possible" options. It is the calling party who "examines" these options.)

the communications connection proper is established if the option of action is found possible. (If the calling party chooses, for example, "put the call through now", paragraph 0031, then the proper communications connection is established.)

Regarding **claim 3**, Tuomela et al. discloses everything claimed as applied above (see *claim 2*). In addition, Tuomela et al. discloses that the data (context information) representing the activity status of the receiving user are fetched from an activity status server (WAP server 7; Figure 2). (See paragraphs 0009 and 0019.)

Regarding **claim 7**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a telephone connection ("phone call" - Figure 2, element 1; "incoming call" - abstract, line 4).

Regarding **claim 8**, Tuomela et al. discloses everything claimed as applied above (see *claim 1*). In addition, Tuomela et al. discloses that the communications connection proper is a text message ("SMS message", "e-mail" - paragraph 0036, lines 4-5).

Regarding **claim 9**, Tuomela et al. discloses a communications connection set-up and checking arrangement (Figure 2), comprising a terminal of the calling party (left-side 10, Figure 2), terminal of the receiving party (right-side 10, Figure 2) and an electrical communications connection between the two parties (call), which arrangement further comprises user-specific activity logs ("context information"). (See paragraphs 0009-0010, 0015-0016, 0019, and claim 1 of Tuomela et al.).

Regarding **claim 10**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses an activity status server (WAP server 7, Figure 2) connected with the user specific activity logs. (See paragraph 0019, and claim 5 of Tuomela et al.).

Regarding **claim 11**, Tuomela et al. discloses everything claimed as applied above (see *claim 10*). In addition, Tuomela et al. discloses that the activity logs are files in the activity status server (Since it is stored in a storage unit it is a "file" as claimed; see paragraph 0009. The WAP-based message is transferred from WAP server 7 to caller's phone equipment; see paragraphs 0013 and 0008. See also, e.g., claim 10 of Tuomela et al.).

Regarding **claim 12**, Tuomela et al. discloses everything claimed as applied above (see *claim 9*). In addition, Tuomela et al. discloses that the activity log is a file in the terminal of the user (context information is stored in the user's phone. See paragraph 0009, and claim 4 of Tuomela et al. Since it is stored in a storage unit it is a "file" as claimed).

Regarding **claim 14**, Tuomela et al. discloses a cellular network (Figure 3) comprising

terminals (MS 10), base stations (BTS 5), base station controllers (BSC 4) and switching centers

(MSC 3), which network further comprises an activity status server (WAP SERVER 7) for

storing a user-specific activity log. (See paragraphs 0034 and 0019).

Regarding **claim 15**, Tuomela et al. discloses everything claimed as applied above (see

claim 14). In addition, Tuomela et al. discloses that the activity status server (7) is connected

with a switching center (3). (See Figure 3).

Regarding **claim 16**, Tuomela et al. discloses a cellular network terminal (MS 10)

comprising a means for entering data (keypad 16) in the terminal, data display means (display

14), data transmission means (transmitter 20), data reception means (receiver 22), memory unit

(memory 13) and a control unit (MCU 12), which terminal further comprises an activity status

monitoring means (CSU 26). (See Figure 3, paragraphs 0037-0040, and 0015).

Regarding **claim 17**, Tuomela et al. discloses everything claimed as applied above (see

claim 16). In addition, Tuomela et al. discloses that part of the memory (13) of the terminal can

be allocated for creating and maintaining a user-specific activity log ("current context"). (See

paragraph 0038).

Regarding **claim 18**, Tuomela et al. discloses everything claimed as applied above (see

claim 16). In addition, Tuomela et al. discloses that part of a SIM card ("removable SIM"),

connected with the terminal, can be allocated for creating and maintaining a user-specific activity

log ("subscriber-related information"). (See paragraph 0038).

Regarding **claim 19**, Tuomela et al. discloses everything claimed as applied above (see

claim 16). In addition, Tuomela et al. further discloses means for displaying (14) activity status

data for the receiving party fetched from an activity status server (WAP server 7). (See

paragraphs 0024-0025 and 0019).

Regarding **claim 20**, Tuomela et al. discloses everything claimed as applied above (see

claim 19). In addition, the mode or means employed by the user to activate or enable context-

sensitive answering read as the claimed "means for making a decision about whether a

communications connection proper will be established" because when enabled it "makes a

decision about" whether to establish the proper communications connection. (See paragraphs

0016-0017).

Regarding **claim 21**, Tuomela et al. discloses everything claimed as applied above (see

claim 1). The process of creating a context-based data is inherently performed by "software

means" or, simply, software (e.g. see "operating program", paragraph 0038). Which software

means is arranged so as to realize the steps of the method according to *claim 1* (explained

above).

Regarding **claim 22**, Tuomela et al. discloses everything claimed as applied above (see

claim 21). In addition, the application program (operating program) is stored on a data transfer

medium, in the memory (13) of a terminal, on a SIM card of a terminal, or in a cellular network

device. (See paragraph 0038).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al.

(US Patent Application Publication US-2001/0031633-A1).

Regarding **claim 13**, Tuomela et al. discloses everything claimed as applied above (see

claim 9). In addition, Tuomela et al. further discloses an user profile editing function (the user

can input or "edit" current context information by means of a keypad 16; paragraph 0008, lines

8-10, paragraph 0015, last three lines, paragraph 0040, lines 3-4, and claim 3 of Tuomela et al.,

inter alia) and an activity status application function ("operating program", paragraph 0038).

However, Tuomela et al. fails to specifically disclose an activity status decoding function

as claimed.

Tuomela et al. teaches that the activity status (current context information) is transferred

to the calling party (caller's phone) in the form of a code that identifies one of a set of animations

stored in the caller's phone for selecting an appropriate one to be displayed to the caller

(paragraph 0018, lines 14-18). The animation can depict the current activity of the called party

(receiving party), for example, in a meeting, on a train, etc. (paragraph 0018, lines 8-10). Thus,

Tuomela et al. suggests "an activity status decoding function" as claimed because the transferred

code is matched with an appropriate animation. One advantage of this is that animations can be

language independent (paragraph 0018, lines 12-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to provide Tuomela et al. with "an activity status decoding function"

because it would enable a language independent feature as suggested by the same Tuomela et al.

8.   **Claims 4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuomela et al.

(US Patent Application Publication US-2001/0031633-A1) in view of Silverman (US Patent

Number 6,035,031).

Regarding **claim 4**, Tuomela et al. discloses everything claimed as applied above (see

claim 2). However, Tuomela et al. fails to specifically disclose that if the option of action

decided upon (e.g. call) is impossible to carry out, it is checked whether the option of action can

be carried out later.

Silverman discloses method wherein if the option of action decided upon (call) is

impossible to carry out, it is checked whether the option of action can be carried out later (call-

back). If the call is impossible to carry out "it is checked whether" a call-back can be carried out

later. See column 3, lines 11-30 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to enable Tuomela et al., if the option of action decided upon is

impossible to carry out, so as to check whether the option of action can be carried out later,

because this would enable the users to communicate in spite of present unavailability of the

called party.

Regarding **claim 5**, Tuomela et al. and Silverman disclose everything claimed as applied

above (see *claim 4*). However, they fail to specifically disclose that if the option of action can be

carried out later, the data representing the activity status of the receiving party are fetched again

after a time delay.

Silverman discloses to perform the call-back within a time delay (timer value); see column 3, lines 30-50. The call-back includes making a phone call to the called party (receiving party); column 3, lines 61-62.

Tuomela et al. discloses that upon a phone call (Figure 2, element 1 of Tuomela et al.), the activity status (context information) of the receiving party are fetched (Figure 2, element 2 of Tuomela et al.). Which in combination with Silverman's call-back is "fetched again after a time delay".

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Tuomela et al., if the option of action can be carried out later, so that the data representing the activity status of the receiving party are fetched again after a time delay, because this would provide the calling party with updated information about the called party since the time elapsed from the first original call to a second successful call can be significant.

Regarding **claim 6**, Tuomela et al. and Silverman disclose everything claimed as applied above (see *claim 4*). However, Tuomela et al. fails to specifically disclose that if the option of action decided upon cannot be carried out after a time delay, a communications connection proper is not established.

Silverman further discloses that if the option of action decided upon (call-back) cannot be carried out after a time delay (timer value), a communications connection proper is not established. For example, the call-back timer value can be set to 30 minutes. If the timer value expires the call-back is terminated and the communications connection proper is not established. See column 3, lines 35-45 of Silverman.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to enable Tuomela et al., if the option of action decided upon cannot be

carried out after a time delay, so that a communications connection proper is not established,

because the wait is too long after the time delay (timer) expires.

Conclusion

9.   Any inquiry concerning this communication from the examiner should be directed to
Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally
be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, David Hudspeth, can be reached on (703) 308-4825. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.
        Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf
September 17, 2004.